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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/616,785	07/10/2003	Lawrence Wasieck	1001.1693101	2009
28075	7590	12/12/2007		
CROMPTON, SEAGER & TUFTE, LLC 1221 NICOLLET AVENUE SUITE 800 MINNEAPOLIS, MN 55403-2420			EXAMINER NGUYEN, VI X	
			ART UNIT 3734	PAPER NUMBER
			MAIL DATE 12/12/2007	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

Application No.

10/616,785

Applicant(s)

WASICEK, LAWRENCE

Examiner

Victor X. Nguyen

Art Unit

3734

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 03 August 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-40 and 44 is/are pending in the application.
- 4a) Of the above claim(s) 9, 16-18, 22, 23, 30-32 and 35-37 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-8, 10-15, 19-21, 24-29, 33-34, 38-40, 44 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- ☐ Notice of Informal Patent Application
- ☐ Other: \_\_\_\_\_

### DETAILED ACTION

1. This Pre-Appeal Brief filed 8/3/2007, with respect to claims 1-8,10-15,19-21,24-29,33-34,38-40 and 44 are acknowledged. Claims 1-40 and 44 are pending. Claims 9,16-18,22-23,30-32 and 35-37 were previously withdrawn from further consideration due to a restriction requirement. However, upon further consideration, a new ground(s) of rejection is made in view of Gray (6,461,370). Rejections based on the cited reference(s) follows.

#### *Claim Rejections - 35 USC § 112*

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 7, 15, 19, 29 and 33 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. In claim 7, the disclosure filed on 7/10/2003 does not describe a connector blends the first flexibility with the second flexibility. Also, in claims 15,19,29 and 33, the disclosure filed on 7/10/2003 does not describe a reduced size portion is defined at least one of the distal end of the proximal region and the proximal end of the distal region, and where both the proximal region and the distal region include a reduced size portion as recited in claims 29 and 33. Clarification is requested.

#### *Claim Rejections - 35 USC § 102*

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-2,4-5,8,10,13,20-21,24,27,34,38-40 and 44 are rejected under 35 U.S.C. 102(e) as being anticipated by Gray et al (6,461,370).

Gray discloses in figures 1-3, a medical device having the limitations as recited in the above listed claims, including: an elongated shaft consists of section 38,54 and 66 combined which includes a proximal section at 38 and a distal section at 66, where a connector 56 connects the proximal section and the distal section, where the connector is fixedly secured to both the proximal section and the distal section, and a filter 50 couples to the shaft, and where the proximal section comprises a first material which is a polyimide tube and the distal section comprises a second material, i.e., a coil spring (see col. 4, lines 54-65) which is different from the first material, where the connector comprises a third material, i.e., braid layer that is compatible for bonding or welded to both the first and second material, and where the device further comprises a covering which is described as a polymer sheath or a bonding sleeve at step 140, figure. 10. As to claims 39-40 and 44, Gray discloses in figures 1-3, an embolic protection filtering device having the limitations as recited in the above listed claims including: a filter assembly 50

couples to the filter wire 38, where the filter assembly includes a filter frame, a filter membrane at 58, and a strut at 52.

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 3,6-7,9,11-12,14,25-26,28 are rejected under 35 U.S.C. 103 (a) as being unpatentable over Gray et al (6,461,370).

Gray et al disclose the invention substantially as claimed. However, Gray is silent regarding the first material comprises stainless steel and the second material includes nickel-titanium alloy or a bismuth alloy disposed adjacent the connector. It would have been obvious to one having ordinary skill in the art at the time the invention was made to construct the first material comprises stainless steel and the second material includes nickel-titanium alloy or a bismuth alloy disposed adjacent the connector, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use or as a matter of obvious design choice. In re Leshin, 125 USPQ 416.

***Response to Arguments***

5. Applicant's arguments with respect to claims 1-8,10-15,19-21,24-29,33,34,38-40 and 44 have been considered but are moot in view of the new ground(s) of rejection. Applicant is asked

Application/Control Number:  
10/616,785  
Art Unit: 3734

Page 5

to please refer to the modified prior art rejection above where the examiner addresses applicant's concerns regarding prior art rejection.

### *Conclusion*

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Victor X. Nguyen whose telephone number is (571) 272-4699. The examiner can normally be reached on M-F (8-4.30 P.M).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Hayes can be reached on (571) 272-4697. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Victor X Nguyen  
Examiner  
Art Unit 3734



VN VN  
12/6/2007



ANH TUAN T. NGUYEN  
SUPERVISORY PATENT EXAMINER

12/10/07